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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,549	06/19/2001	Michael J. Lemon	10007916-1	2371

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
2675	11

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,549

Applicant(s)

LEMON, MICHAEL J.

Examiner

Ming-Hun Liu

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 3 is objected to because the word "tablet" is misspelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,456,307 to Bates.

In reference to claim 1, Bates teaches an annotating system for Internet data addresses where the device allocates a temporary location that links the location to the address of a preselected Internet website (column 2, lines 20-23). Several marked locations can be generated and each are symbolically linked to their respective Internet websites (column 3, lines 23-26). The Internet website is invoked when the user selects the icon (column 10, lines 46-47).

However, Bates does not go into depth on the possible GUI alternatives in this annotation system.

On column 5, lines 26-29, Bates acknowledges that several different inputting methods are possible specifically sighting a graphic tablet as the first alternative to the conventional mouse. As one skilled in the art understands, graphical tablets inherently include styluses for pointing and invocation purposes. Therefore from aforementioned concession of Bates, it is

understood that selecting process as understood in Bates' disclosure includes selecting with pointing devices alternative devices such as the graphical tablet and stylus combination.

In reference to 2, figure 11B of Bates demonstrates a first surface region where the annotating function commands are implemented (area 750).

4. Claims 3, 5-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over combination Bates and US patent 5,592,607 to Weber et al.

In reference to claim 3, Bates describes an Internet address representation scheme that is similar to the applicant's claimed invention. The functionality of the Bates and the applicant's inventions is essentially synonymous, however their method of annotation differs. Bates' invention uses the computer to generate customizable graphical bookmarks of the webpage whereas the applicant's invention allows the user to create freehand graphical bookmarks of the webpage.

Weber teaches an invention that allows the user to link freehand written images to certain addresses within the computer (column 1, line 25-30 and column 5, lines 4-16). Naturally Weber's invention differs from the applicant's invention where the applicant's device specifically links graphics to Internet addresses. As Weber teaches in column 4, lines 36-38, that an "address" of an event "is a point in a measurement dimension that can be used later to facilitate access to that point."

One skilled in the art understands that Internet addresses are certainly events that need to be recalled a fact that is well established by Bates.

It would have been obvious to combine Bates' and Weber's invention to serve as a new, intuitive event reference method for Internet addresses.

Claims 5 and 6 are rejected using the combination of Bates and Weber with the reasoning outlined in the rejection of claim 3. As Weber illustrates in figure 14, the graphical references are randomly located to represent separate links to separate addresses (column 25, lines 47-53).

In reference to claim 7, on column 26, line 34, Weber teaches that the maker can be deleted from the workspace.

Claim 8 is rejected on basis outlined in the rejection of claims 3, 5 and 6.

In reference to claim 9, Weber teaches that the location of the marker can also define the link to the address (column 6, lines 23-27).

In reference to claim 10, Weber does not explicitly state that erasing the marking will disassociate the location link to the Internet address, however such a disassociation is implied in the functionality of a deletion process. Weber teaches on column 26, lines 37-44 that the physical marking along with its address relationship is stripped from memory.

Claim 11 is rejected on the ground outlined in the rejection of claims 3 and 7.

In reference to claim 12, as seen from figures 14 and 15 that Weber teaches the uses of several function keys and stroke patterns for the functioning of the tablet.

Claim 13 is rejected on the ground outlined in the rejection of claim 9.

In reference to claim 14, Weber's invention allows the user to instantly retrieve an addressed event by selecting the corresponding graphical representation (column 26, 45-50).

Claim 15, 17 and 18 are rejected on basis outlined in the rejection of claim 8.

Claim 19 is rejected on basis outlined in the rejection of claim 9.

In reference to claim 20, the concept of jumping from on address to address is anticipated by Weber and explained in the rejection of claim 14. Furthermore, this limitation is inherent to the definition of an Internet bookmark as Bates would attest. Bookmarks were created to allow the users to jump from site to site (column10, line 46-47).

### ***Response to Arguments***

5. Applicant's arguments filed 4/12/2004 have been fully considered but they are not persuasive.

Referring to the arguments concerning claim 1, the applicant argues that the Bates reference is insufficient in anticipating the claimed invention. That argument is incorrect. The applicant sites differences such as Bates lacks the use of a "temporary mnemonic-type free had writing", however the claim language never suggests such a limitation. Furthermore, in response to the argument that the icon is a computer-generated representation is also moot since, nowhere in the claim does the applicant suggest otherwise. The applicant also argues that the difference between absolute and relative coordinate mode, a limitation that is also absent from the claim language. Finally, spontaneity is not claimed formally claimed by the applicant. Even if the spontaneous requirement was somehow established in the claim language, Bates' invention also allows for the spontaneous creation of an Internet shortcut.

In response to arguments concerning claim 3, the examiner believes firmly that Internet address are known in the art as being commonly referenced values in computing devices. A computer address (used in the context of Weber's invention) is a memory location dedicated for

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storage. As ones skilled in the art understands as demonstrated by the numerous references sighted (Bates and Dickman) Internet addresses are being stored/bookmarked to allow quick access to favorite Internet sites. Internet address is a specific type of address storage that is commonly known in the art and neither personal hindsight nor extrapolation was used to determine this relationship.

In reference to the arguments for claims 5-15 and 7-20, the arguments regarding the rejection of these claims are merely recitations of the original claim or assertions that the examiner is incorrect. The applicant offers no new arguments that establish the need for a withdrawal of the rejection. Therefore, the examiner's rejections will be maintained.

In conclusion, the examiner believes that the Weber invention firmly establishes the idea of a tablet with a stylus that is capable of creating mnemonic representations, associated with a specific location within the tablet, that refer to particular addresses in computing memory. Weber's invention encompasses most of the elements claimed by the applicant. The missing link between Weber's invention and the applicant's is the exclusive use of the applicant's invention with Internet addresses. The examiner believes that this void is adequately addressed by references such as Dickman and Bates.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

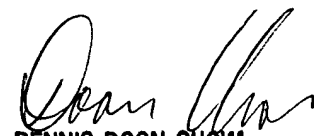
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ming-Hun Liu

  
DENNIS-DOON CHOW  
PRIMARY EXAMINER